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IN THE

# SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1964.

## No. 580

WILLIAM T. GRAHAM and GRAHAM PLOW, INC.,
*Petitioners,*

vs.

JOHN DEERE COMPANY OF KANSAS CITY and DEERE & COMPANY,
*Respondents.*

### BRIEF OPPOSING PETITION FOR CERTIORARI

To the Honorable Supreme Court of the United States:

Respondents, JOHN DEERE COMPANY OF KANSAS CITY and DEERE & COMPANY, oppose the petition for writ of certiorari and respectfully present the following matters for the Court's consideration.

### OPINIONS OF THE COURTS BELOW

The Opinions below are correctly reported in and appended to the petition.

## JURISDICTION

Jurisdiction is not questioned.

## QUESTIONS PRESENTED FOR REVIEW

The sole question for review is the validity of United States Patent No. 2,627,798.

## CONSTITUTIONAL PROVISIONS, STATUTES AND RULES INVOLVED

In addition to the statutes cited by Petitioners, it may be appropriate to consider 35 U.S.C., § 112, in connection with Petitioners' arguments at pages 11-13 of the petition and Section 112 is therefore included herein as Appendix "A"

## STATEMENT OF THE CASE

Petitioners' statement of the case is substantially accurate in most respects but it is somewhat slanted and argumentative. We therefore do not accept it and submit the following statement in lieu thereof.

This is a patent suit. The patent in issue is United States Patent No. 2,627,798, entitled "Clamp for Vibrating Shank Plows", issued to W. T. Graham on February 10, 1953. (R. 577) Stripped of all artifice, the patent relates to a spring clamp for attaching the shank of a ground working tool to the frame of a plow, the essential purpose of which is to permit the tool to pivot under spring pressure when rocks or other obstructions are encountered in the soil and return to operating position after the obstruction

is cleared. Sheet 1 of the patent drawings adequately reveals the structure and for convenience of reference same is attached hereto as Appendix "B".

The District Court held the patent valid and infringed, *Graham* v. *John Deere Company of Kansas City*, 216 F. Supp. 272 (W.D. of Mo.) (March 18, 1963). The Court of Appeals for the Eighth Circuit reversed, holding the patent invalid for lack of invention and did not pass on the question of infringement, *John Deere Company of Kansas City* v. *Graham*, 333 F.2d 529 (8th Cir.) (June 18, 1964).

## ARGUMENT

Petitioners advance three reasons for review by this Court, to wit:

1. There is a square conflict between the decision below, in which the Eighth Circuit held the patent invalid for lack of invention, and two former decisions of the Court of Appeals for the Fifth Circuit which held the patent valid, *Jeoffroy Mfg.* v. *Graham*, 219 F.2d 511 (1955), and *Graham* v. *Cockshutt Farm Equipment*, 256 F.2d 358 (1958).

2. The test of invention applied by the Eighth Circuit is contrary to Section 103 of the 1952 Patent Act, 35 U.S.C., § 103, and the test of invention under the Act is an important question of federal law whch has not been, but should be, settled by this Court.

3. The Eighth Circuit's review of the findings of fact of the District Court is in conflict with Rule 52 of the Federal Rules of Civil Procedure, decisions of this Court and decisions of other courts of appeal.

We respectfully submit that grounds 2 and 3 are unfounded and that under the circumstances here existing

the conflict of decision between the Eighth and Fifth Circuits does not call for review by this Court.

**The Conflicting Decisions**

Admittedly, there is a square conflict but we submit that the decision of the Eighth Circuit is so clearly in accord with the law established by this Court that certiorari would serve no useful purpose except to correct the erroneous concept of the Fifth Circuit, and that is not a sufficient reason for granting certiorari.

It is absolutely clear from the findings of the Courts below (and also from the findings in the *Jeoffroy* and *Cockshutt* cases) that the Graham 798 patent *reveals no new element* and is only *a combination of elements old in the art*, all of which elements are found in a broad sense in a single prior art structure, the Glencoe Spring Clamp. [The structure of Glencoe is adequately shown in the Rolf Patent No. 2,739,518 (R. 629) and for convenience of reference we attach the sheet of drawings therefrom as Appendix "C".] For such combinations of old elements, this Court has specifically established both negative and positive tests or standards of invention.

The negative standard was crystallized in *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U.S. 545, 549 (1937), as follows:

> "The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them is not patentable invention."

To the same effect are *Altoona Public Theatres* v. *American Tri-Ergon Corporation*, 294 U.S. 477, 486 (1934); *Toledo Pressed Steel Co.* v. *Standard Parts, Inc.*, 307 U.S. 350, 355

(1939); and *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84, 88 (1941).

The positive test was stated in *Great A & P Tea Co.* v. *Supermarket Equip. Corp.*, 340 U.S. 147, 152 (1950), as follows:

> "The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable. Elements may, of course, especially in chemistry or electronics, take on some new quality or function from being brought into concert, but this is not a usual result of uniting elements old in mechanics. This case is wanting in any unusual or surprising consequences from the unification of the elements here concerned, and there is nothing to indicate that the lower courts scrutinized the claims in the light of this rather severe test."

Paraphrased, the positive test is that in order to constitute invention the combination of old elements must produce some new, unexpected or surprising result or consequence. This rule is the law of the land; it has been expressly followed in literally hundreds of cases; it has been consistently followed by the Eighth Circuit and it was meticulously tracked by that Court in its decision below.

It is crystal clear from the findings of the District Court that it did not find any new, unexpected or surprising result or consequence in the Graham 798 combination. It did find "an improved functional result", the improvements being: (1) the arrangement of the shank below the plate portion of the pivoted member which permits the forward portion of the shank to flex downwardly away from the plate portion of the fixed member, and (2) reduction of wear and tear to some parts of the clamp. There are *no other findings of achievement* and upon their face those findings do not satisfy either the negative test

as stated in *Lincoln Engineering* v. *Stewart-Warner* or the positive test laid down in *A & P*. The Eighth Circuit therefore held that the District Court had not applied the correct and required test or standard and that the patent was invalid for lack of invention. In so holding, the Eighth Circuit followed precisely the law as laid down by this Court.

By comparison, we respectfully submit that the Fifth Circuit, in holding the patent valid in the *Jeoffroy* and *Cockshutt* cases, paid lip service to the rules of this Court but did not apply them.

In the *Jeoffroy* case the District Court, even without the benefit of the Glencoe prior art clamp, found the Graham 798 patent invalid for lack of invention, saying (R. 915):

> "* * * This patent 798 does mark an improvement bettering efficiency and economy over patent 811, but that is not enough to constitute invention. The said patent 811 was the spring board and from that vantage background the next step from that structure to the structure of patent 798, was well within the capacity of a skilled mechanic."

In reversing the District Court the Fifth Circuit said, 219 F.2d, at page 518:

> "* * * Though we do agree that 798, as an improvement combination, is not entitled to any broad degree of protection over 811, it still seems to us that its hybrid type structure combining the wear-resisting rotating pivot, in part reminiscent of the prior art, with the new shank and stirrup arrangement permitting some of that same advantageous flexibility inherent in the old 811 structure, reveals sufficient indicia of novelty and invention to justify limited protection.

> * * * Other factors strongly influencing and, we think, reinforcing our conclusion as to the validity of 798 are: * * * (3) the further rule, long recognized by this court, that an improvement combination is patentable even though its constituent elements are singly revealed by the prior art, where, as here, it produces an old result in a cheaper and otherwise more advantageous way; * * *."

There was no finding of any new, unexpected or surprising result or consequence. On the contrary, the only finding of achievement was "an old result in a cheaper and otherwise more advantageous way". That was the real basis for the finding of invention and the Fifth Circuit expressly so stated in *Graham* v. *Cockshutt*, 256 F.2d, at page 359, as follows:

> "We conclude, however, after careful consideration, that our decision previously made as to the validity of this patent should stand. * * *
>
> "As pointed out above, no part of this device is itself patented or subject to patent, since every one of the parts is old, and its use independently in the present combination is a long known use. *It is only because this particular arrangement of these known elements adopted by Graham achieves the result better than the prior art afforded that Graham was entitled to a patent.*" (Emphasis added.)

The conflict between the Eighth Circuit and the Fifth Circuit is clear, but it is equally clear that the Eighth Circuit has followed and applied the standards announced by this Court while the Fifth Circuit has not and no valid purpose would be served for this Court to grant a writ and restate the law which it has so clearly established heretofore.

**The Test of Invention Applied by the Eighth Circuit Is Not in Conflict with the Statutes**

Petitioners argue that in requiring a new or unexpected result or consequence as the test of invention, the Eighth Circuit was relying upon the decisions of this Court in the *Cuno* and *A & P* cases, that those decisions were before passage of the 1952 Patent Act, that Section 103 of the Act does not contain the new or unexpected result or consequence test, and that such a test is in conflict with Section 103. Stripped to its vitals, the argument is, in effect, that Section 103 established a new test and nullified the *A & P* standard. This is not a new argument. It was made almost immediately after the adoption of the 1952 Act and the courts have repeatedly held that Section 103 did not establish any new test but merely codified a hundred years of decisional patent law, including *A & P*. *Stanley Works* v. *Rockwell Mfg. Co.*, 203 F.2d 846, 849 (3rd Cir. 1953); *General Motors Corp.* v. *Estate Stove Co.*, 203 F.2d 912, 918 (6th Cir. 1953); *Interstate Rubber Prod. Corp.* v. *Radiator Specialty Co.*, 214 F.2d 546, 548 (4th Cir. 1954); *Wasserman* v. *Burgess & Blacher Co.*, 217 F.2d 402, 404 (1st Cir. 1954); *John Blue Co.* v. *Dempster Mill Mfg. Co.*, 275 F.2d 668, 671 (8th Cir. 1960).

At the time of *Cuno, Lincoln Engineering* and *A & P* the settled law was that a structure, although new and useful, did not involve invention if it would have been obvious to one skilled in the art. Within that broad rule this Court said combinations of old mechanical elements are obvious and non-inventive unless they produce some new, unexpected or surprising result or consequence. The broad test was codified in Section 103 and there is neither legislative history nor logic to support the argument that

the more specific test for combinations of old mechanical elements was thereby rejected.

Petitioners further urge that the decision of the Eighth Circuit is in conflict with 35 U.S.C., § 282, because the Court stated in its opinion that "the presumption of validity is weakened if applicable prior art is not considered by the Patent Office." Petitioners contend that the presumption is weakened only if the prior art not considered by the Patent Office is more pertinent than the art which was considered. This argument is ill founded for three reasons:

First, it disregards the full context of the Court's statement, and we quote from 333 F.2d, at page 530:

> "Appellees urge and rely upon the uncontroverted rule, established by statute and consistently recognized by the courts, that a patent shall be presumed valid and that the burden of establishing invalidity of a patent shall rest on the party asserting it. * * * It is equally clear, however, that the presumption of validity is a rebuttable one, that when substantial evidence attacking the validity of a patent is introduced, the question whether the patent constitutes an invention is for the court, * * * and that the presumption of validity is weakened if applicable prior art is not considered by the Patent Office."

The Court held that the presumption of validity was overcome by the whole proof in the record and not by any one factor alone.

Second, the rule that the presumption of validity is weakened by the failure of the Patent Office to consider pertinent art is not limited to a failure to consider more pertinent art. The presumption of validity is based in part upon the theory that the Patent Office routinely considers the pertinent prior art before a patent is is-

sued. Thus, when it appears that pertinent art was not considered there is no reason for indulging the presumption and it is of little consequence. The Courts so hold. In *Jacuzzi Bros.* v. *Berkley Pump Co.*, 191 F.2d 632, 634 (9th Cir. 1951), the Court said:

> "* * * Even one prior art reference, which has not been considered by the Patent Office, may overthrow the presumption of validity, and, when the most pertinent art has not been brought to the attention of the administrative body, the presumption is largely dissipated."

To the same effect are *Day-Bright Lighting, Inc.*, v. *Sandee Mfg. Co.*, 286 F.2d 596, 597 (7th Cir. 1960); *O'Leary* v. *Liggett Drug Co.*, 150 F.2d 656, 664 (6th Cir. 1945); *Cornell* v. *Adams Engineering Co.*, 258 F.2d 874, 875 (5th Cir. 1958); *Elliott & Co.* v. *Youngstown Mfg. Co.*, 181 Fed. 345, 349 (3rd Cir. 1910); *R. Hoe & Co.* v. *Goss Printing Press Co.*, 30 F.2d 271, 274 (2nd Cir. 1929).

Third, even if the presumption were weakened only by a failure to consider more pertinent art, it is clear beyond any question that the Glencoe Spring Clamp, not considered by the Patent Office, is more pertinent than any of the art which was considered. The Trial Court expressly found (Finding XII) that "in a broad sense all of the elements are found in one single reference, the Glencoe clamp," and even a cursory examination of Glencoe (Appendix "C") reveals that every mechanical element of Graham's 798 clamp is present in Glencoe and that the only essential difference is that Graham is arranged with the shank *below* the plate portion of the pivoted member, whereas Glencoe is arranged with the shank *above* the plate portion of the pivoted member.

Section 282, declaring the presumption of validity, codified a long-standing judicial rule and the Eighth Circuit merely held, as courts have long held, that the presumption of validity was overcome by the proof. There is no conflict with the statute.

**The Eighth Circuit's Review of the Findings of Fact Is Not in Conflict with Rule 52**

Apparently Petitioners' charge of error in fact review is only a "make weight" since they do not even devote a section of their argument thereto. Under their heading "The Patent in Suit Meets the Test of Invention" they do briefly argue, on page 13, that the Court disregarded Rule 52. The theme of their argument is not clear but apparently it is two-fold: first, that the Court disregarded the District Court's finding "that none of the prior art structures were *like* the patent structure"; and, second, that the Court disregarded the Trial Court's finding that "the flexing provided by the patent structure was significant".

On the first phase of the argument we fail to see any finding by the District Court "that none of the prior art structures were like the patent structure". The District Court did not phrase any finding in that language. It did say, in Finding XII, that "the particular arrangement of the elements disclosed by 798 is not present in any single reference or as a whole" and the Eighth Circuit gave full credence to that finding. It merely held that the differences in arrangement did not produce any new or unexpected result or consequence and the differences were thus insufficient to constitute invention. This is review strictly in accordance with the rule announced by this Court in the *A & P* case. The Court of Appeal applied the proper legal standard to the facts as found by the Trial Court and they fell short of the mark.

The second phase of Petitioners' fragmentary argument requires somewhat more analysis. In its Findings of Fact XIII and XIV the Trial Court found that the Graham 798 arrangement of the plate portion of the pivoted member above the shank permits the forward portion of the shank to flex downwardly away from the plate member in a manner different from the prior art and Finding XIV contains the following statement:

> "The Graham 798 patent is an improvement patent and, while the individual mechanical elements may be found in the prior art, taken as a whole the Graham 798 structure is sufficiently different in the operative relationship of the shank and pivoted member with a *slight but significant difference in the flexing of the forward portion of the shank* that is not found in the prior art, so that the Graham 798 patent involves invention." (Emphasis added.)

Petitioners apparently argue that the Eighth Circuit disregarded that finding and ruled that any such flexing is insignificant.

Again, this is an argument that misconstrues the Court's opinion. At page 534 of the Opinion, the Court assumed that the slight difference in flexing of the forward portion of the shank, as found by the Trial Court, does exist and that the inversion of the parts which produces that difference of flex does perhaps result in a more efficient structure, but it pointed out that the slight difference in relative direction of flex of the shank away from the plate member rather than against the plate member would have been *an obvious result of the inversion* to a person having ordinary skill in the art. Thus, the Trial Court's finding of invention was without adequate evidentiary support in the record and was clearly erroneous. This is review precisely in accordance with Rule 52.

Furthermore, even if the Eighth Circuit had ruled that the slight difference in shank flex was of no significance whatsoever, even as to improve efficiency, the ruling would be correct because the only evidence in the record is that such flex is unimportant. Petitioners' own expert, Mr. Fenton, testified as follows (R. 548):

> "Q. Do you regard the small degree of flex in the forward end of the shank that lies between the pivot point and the point of spring attachment to be of any significance or any importance to the functioning of a device such as 798?
>
> "A. Unless you are approaching the elastic limit, I think this flexing will reduce the maximum stress at the point of pivot there, where the maximum stress does occur. I think it will reduce that. I don't know how much.
>
> "Q. Do you think it is a substantial factor, a factor of importance in the functioning of this structure?
>
> "A. Not a great factor, no."

Similar testimony was given by him in the *Jeoffroy* case and pointed out in this case (R. 548-549) as follows:

> "Q. * * * Do you consider this portion, this what you call the resilient action of the shank, Mr. Fenton, in the forward 8 or 9 inches of that shank that's up inside the mounting or bracket, important to the function of the device?
>
> "A. Not too important. It is present, but not too important.
>
> "Q. It would function just as well whether that were there or not, wouldn't it?
>
> "A. In this particular case and this device?
>
> "Q. Yes, sir.
>
> "A. I think it would essentially, yes."

Respondents' expert, Mr. Fishleigh, testified that in spring steel shanks of the type under consideration there is pro-

vision in the long curved rearwardly extending portion of the shank for large ranges of flexion and that in actual operation there is a great deal of flex in that part of the shank, but that in the forward portion of the shank, within the clamp, the range of flexion is extremely small, only a few thousandths of an inch at most, and that such flexion is of no consequence to the operation. (R. 364, 479.) Any finding that the asserted shank flex was significant is thus unsupported by evidence and is clearly erroneous. Rule 52 authorizes the setting aside of such findings.

Petitioners further argue that Respondents made their clamps so that they would have the alleged flex and that such flex had to be significant. Otherwise, they say, Respondents would have made their clamps with the shank above the plate as in the prior art. No reference is made to the record and this argument is whole cloth imagination of counsel.

Petitioners' argument that the Eighth Circuit violated Rule 52 borders on frivolity and is wholly without merit.

**The Patent Does Not Meet the Test of Invention**

The petition contains a subdivision entitled "The Patent in Suit Meets the Test of Invention". The arguments thereunder have little or nothing to do with the assigned reasons for granting certiorari and any response may be superfluous but we do not feel that the arguments should go unchallenged.

Petitioners first inquire whether the 798 clamp was *new* and *useful*. We assume, for purposes of argument, that it was useful, although Graham has never manufactured or sold it, that it was new or novel in the sense that the precise form and arrangement of the parts were not found in the prior art and that the requirements of

35 U.S.C., § 101 and § 102, were met. That leaves open, however, the third important requirement—INVENTION—and Petitioners wholly fail to discuss that requirement.

We respectfully submit that the Graham 798 clamp involves nothing more than inversion of the Glencoe shank and pivoted member and modifications of form of some parts for adaptation to the Graham plow. This is elementary mechanics with obvious results and no matter how the test of invention is phrased, 798 falls short.

Petitioners chastise the Court for pointing out that the patent does not mention "the shank flex which became the basic reason for sustaining the validity of the patent in the Trial Court" and for holding that "the failure of the specification and claims to spell out function and result was a fatal defect" which rendered the patent invalid. They offer as excuses for the failure of the patent to disclose its crux of invention—the slight flex of the shank away from the plate of the pivoted member—the proposition that the statute (They do not say what statute, but we may assume that they mean 35 U.S.C., § 112.) only requires that the specifications and claims disclose the structure and that any claim of function would have been improper under the authority of *Halliburton Oil Well Cementing Co.* v. *Walker,* 329 U.S. 1 (1946). This argument is without merit from beginning to end.

In the first place, the Eighth Circuit did not *hold* that the patent was invalid because it failed to disclose or claim the shank flex function. The Court merely pointed out the significant fact that if such shank flex was so important, if it was the crux of invention, it was strange that no mention was made thereof in the patent. Since shank flex was not of sufficient consequence to mention

in the patent or the file history it would hardly seem sufficient to support invention. A precise parallel is *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U.S. 545, 550 (1937), where this Court said:

> "* * * the respondent * * * urges that in the combination of the Butler patent, the headed nipple performs a new and different function from that which it had heretofore performed, in other combinations, in that, when the coupler is drawn from the nipple, at the end of the greasing operation, the rounded head of the nipple 'cocks' the jaws of the coupler for the next operation. *The suggestion seems to be an afterthought. No such function of the nipple is hinted at in the specifications of the patent. If this were so vital an element of the functioning of the apparatus it is strange that all mention of it was omitted.*" (Emphasis added.)

See, also, the *A & P* case where this Court said, at page 149:

> "Since the courts below perceived invention only in an extension of the counter, we must first determine whether they were right in so doing. We think not. In the first place, the extension is not mentioned in the claims, except perhaps, by a construction too strained to be consistent with the clarity required of claims which define the boundaries of a patent monopoly."

The plain truth is that in the courts below Petitioners urged "flex of the forward portion of the shank downwardly away from the plate of the pivoted member" as the heart and soul of the inventive concept of this patent yet that vital function or achievement was never mentioned or even hinted at in the specifications and claims or in any of the Patent Office proceedings. (See the file history at R. 659, *et seq.*) It was and is a pure afterthought

brought forward by counsel in a last-ditch effort to salvage this patent in the courthouse.

In the second place, counsel's wail that the patent disclosed and claimed structure, as required by the statute, and that function could not be claimed, reflects shallow analysis that may be quickly dispelled.

In the *Halliburton* case, this Court held claims invalid under the statute then in force, Rev. Stat. § 4888 (35 U.S. C.A., Appendix II, page 818), because they wholly failed to define structure and were functional only in the crucial area of alleged invention. Such a wholly functional claim would perhaps be insufficient under the present disclosure requirements of 35 U.S.C., § 112, but the second and third paragraphs thereof now provide as follows:

> "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
>
> "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

Under the provisions of the second paragraph it may well be that Graham was required to assert the shank flex in his claims, if that was in fact the crux of his alleged invention, but we need not cross that bridge since it is absolutely clear under the express provisions of the third paragraph that he was entitled to define the shank flex function in conjunction with the structural arrangement of the combination. Furthermore, there is absolutely nothing in the statutes which would have prevented him from

disclosing the alleged vital function in his specifications whether it was included in the claims or not.

The simple truth is that the Eighth Circuit rejected this patent for lack of invention and not for deficiency of disclosure and Petitioners' argument that the patent complied with the statutory requirements of disclosure has nothing to do with the reasons advanced for granting certiorari.

We respectfully submit that the Eighth Circuit held this patent invalid for lack of invention upon a record which permits no other conclusion. In doing so, it gave full effect to the applicable statutes and followed precisely the law laid down by this Court.

## CONCLUSION

In conclusion, we respectfully submit that the only ground for certiorari which deserves any consideration is the conflict of decision between the Fifth and Eighth Circuits and on that point the decision of the Eighth Circuit is so clearly correct the petition should be denied.

Respectfully submitted,

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## APPENDIX "A"

35 U.S.C., §112

"§112. Specification

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

"An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material or acts described in the specification and equivalents thereof. July 19, 1952, c. 950, §1, 66 Stat. 798."

Feb. 10, 1953 W. T. GRAHAM 2,627,798

CLAMP FOR VIBRATING SHANK PLOWS

Filed Aug. 27. 1951 4 Sheets-Sheet 1

Fig. 1.

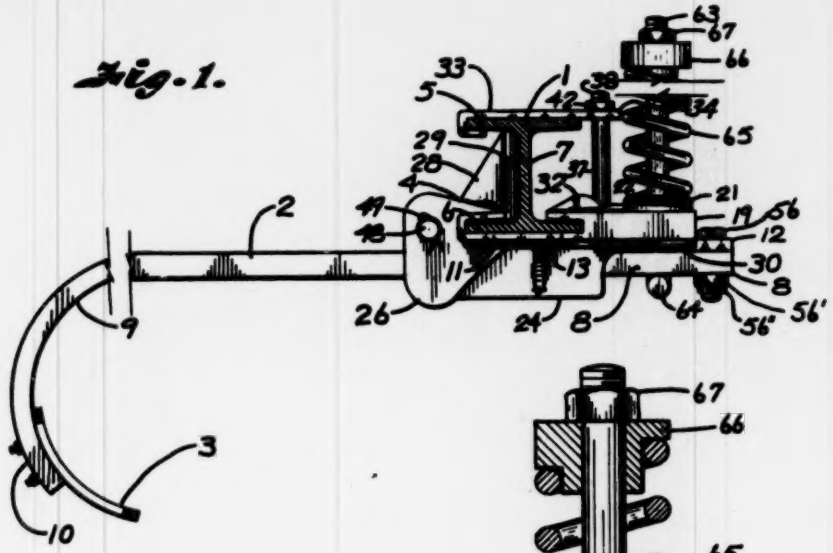
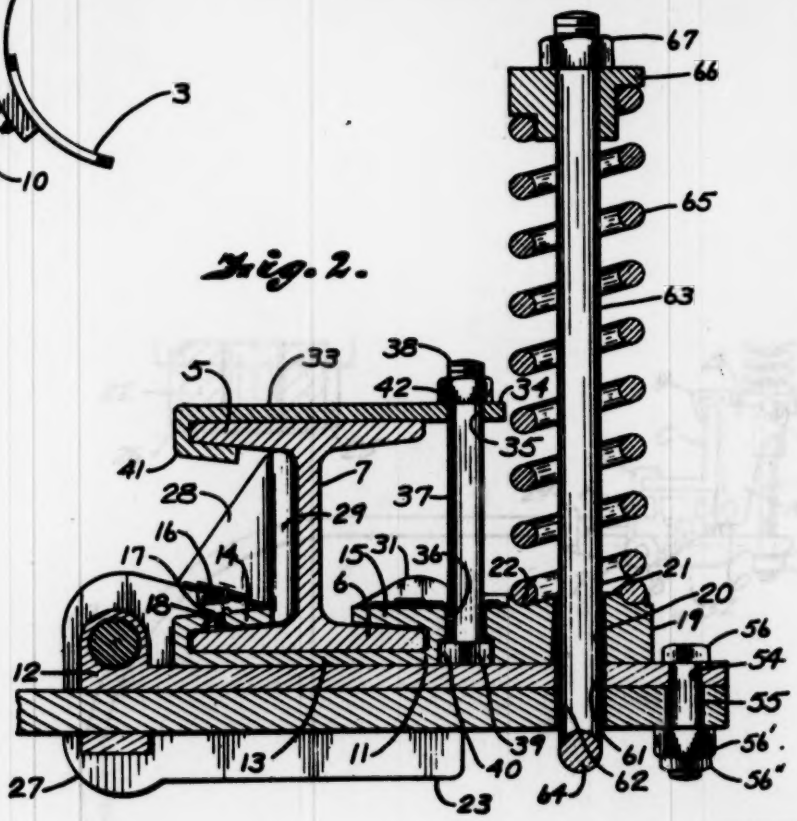



Fig. 2.




INVENTOR.
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BY
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March 27, 1956 E. A. ROLF 2,739,518

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FIG. 2

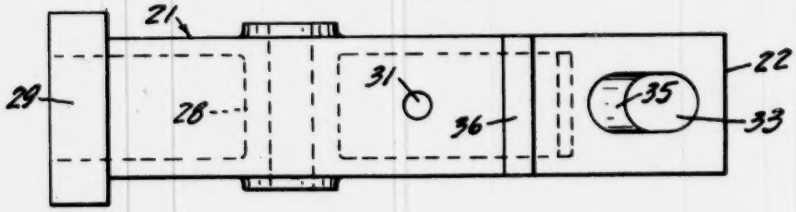



FIG. 3

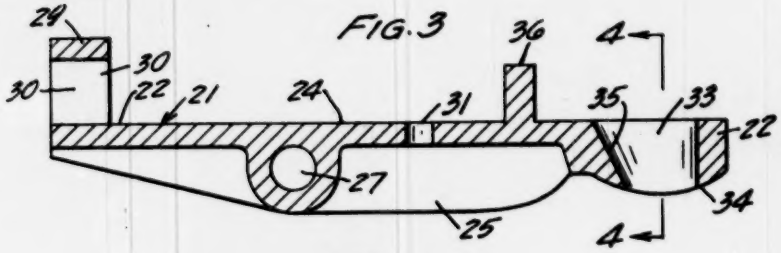
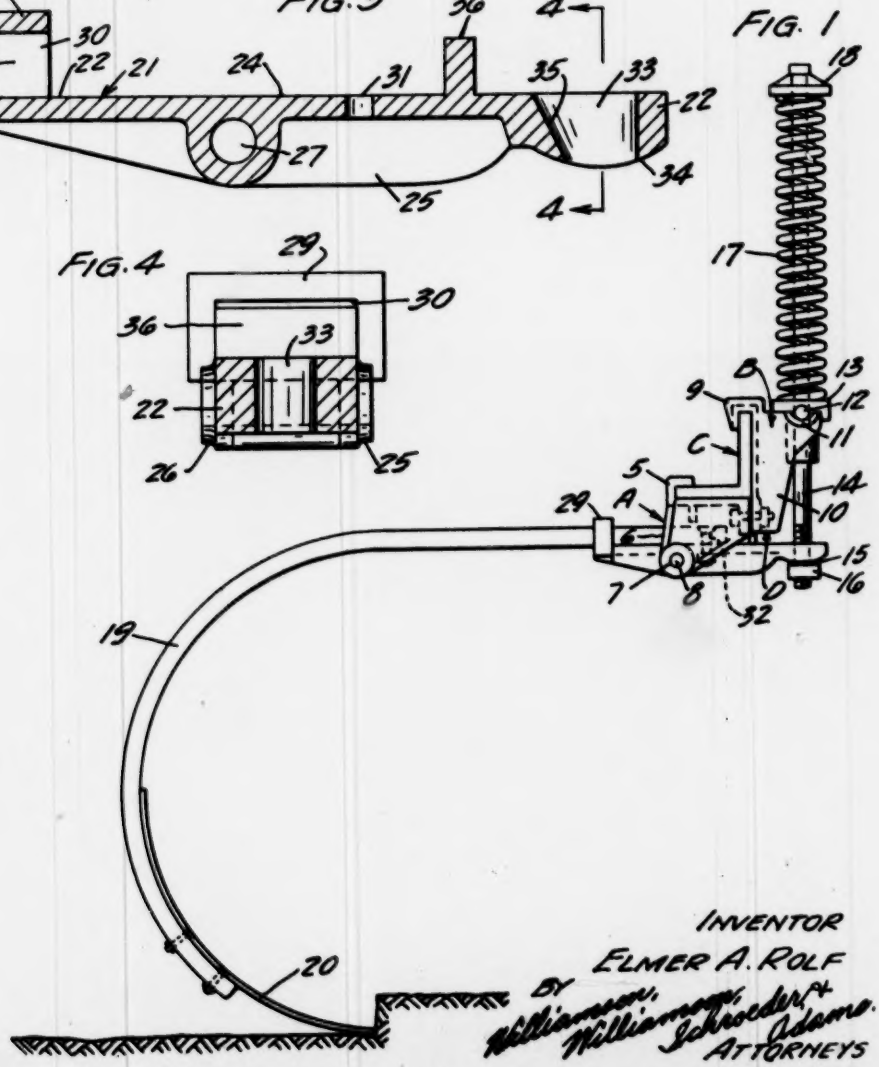



FIG. 4




FIG. 1

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